

## REMARKS

Upon entry of the present amendment claims 1-24 are pending in the application. No claims have been amended. Claims 25-27 were previously canceled. No new claims have been added.

Amendments to, cancellation of, and additions to, the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

### 1. **Restriction Requirement Under 35 U.S.C. §121/372**

It is the PTO's position that restriction is required between the inventions of Group I, claims 1-15, drawn to a pigment mixture, and Group II, claims 16-24, drawn to a method of making a pigment mixture. Restriction is said to be appropriate on the grounds that the claims lack unity of invention. In particular, the PTO states

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: DE 10027293 discloses a pigment composition containing a platelet aluminum effect pigment coated with polymer and a transparent powdery coating. The aluminum pigment's implicit property has a ratio of thickness to diameter in a range of 0.02-0.002. The polymer coating is a leaflet-shape particle. The aluminum platelet effect pigment is coated on the polymer-the leaflet-shape particle. The effect pigment has an aspect ratio of  $1/0.02=50$  to  $1/0.002=500$  (i.e. this reads on leaflet-shaped). The transparent powder pigment is such as titanium oxide.

*Office Action of 1 April, 2009, page 2.*

Applicants greatly appreciate the PTO's detailed comments but must respectfully disagree and traverse the restriction requirement.

First, the corresponding special technical feature common to claims 1 and 16 is not a pigment composition containing a platelet effect pigment coated with a polymer.

Rather, the technical feature common to the composition of Applicants' claim 1 and Applicants' process of claim 16 for producing the composition of claim 1 is a pulverulent coating composition comprising a leaflet-shaped particle comprising a leaflet-shaped effect pigment in complete or near-complete parallel orientation to the surface of the leaflet-shaped particles (A), and transparent, dimensionally stable, leaflet or non-leaflet-shaped particles (B) having a ratio of laminar diameter D to layer thickness d, i.e.,  $D:d$  of  $< 10:1$  which are free from leaflet-shaped effect pigments. That is, Applicants' claimed inventions require a mixture of particular particles (A) and particular particles (B).

Second, Applicants' pulverulent coating composition is not anticipated by the disclosures of DE 10027293 et al.

Indeed, all the English Abstract of DE 10027293 teaches is that the disclosed coating composition contains at least one effect pigment that is coated with an oligomer or polymer. (*Abstract*, '293).

The English Abstract is silent as to any of the requirements cited by the PTO to fulfill the requirement of the claimed inventions. Nor has the PTO offered any citations to the German language document supporting the location of the information relied upon. Moreover, the PTO is silent as to where DE '293 teaches Applicants' required limitation that the particles (A) "...compris[e] at least one leaflet-shaped effect pigment in complete or near-complete parallel orientation to the surface of the leaflet-shaped particles...". In the absence of this limitation, it cannot be said that Applicants' inventions of claims 1 and 16 are disclosed.

Finally, no support is offered by the PTO for the proposition that titanium dioxide is a transparent material. Rather, those of skill in the art know that titanium dioxide is an opaque pigment.

Thus, the PTO has completely failed to explain how DE '293 disclosed Applicants required mixture of particular particles (A) and (B).

Accordingly, it is submitted that the PTO has failed to establish any record that Applicants' special technical feature is disclosed in the cited prior art.

In view of these arguments, it is respectfully submitted that unity of invention does exist. Accordingly, restriction is not permissible under 37 CFR 1.499. Reconsideration and removal of the restriction requirement is respectfully requested.

However, per the requirements of 37 CFR 1.499 and 37 CFR 1.43, Applicants hereby elect the invention of Group I, claims 1-15 with traverse. If the restriction requirement is maintained, Applicants hereby authorize the cancellation of claims 16-24 as being drawn to a nonelected invention.

## CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

/MaryEGolota/  
Mary E. Golota  
Registration No. 36,814  
Cantor Colburn LLP  
(248) 524-2300

May 1, 2009

## CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION  
1609 Biddle Avenue  
WYANDOTTE, MI 48192  
Customer No. 26922

MEG